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10/702,225

11/05/2003

Harry H. Lu

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EXAMINER

HARMON, CHRISTOPHER R

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 05/18/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/702,225  
Filing Date: November 05, 2003  
Appellant(s): LU ET AL.

**MAILED**  
**MAY 18 2006**  
**Group 3700**

\_\_\_\_\_  
Christopher Jacobs  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/13/06 appealing from the Office action mailed 7/14/05. It is noted that the appeal brief erroneously has headings directed towards application no. 09/150,819 on pages 2+. These headings are disregarded

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,468,556	Fuss	11-1995
6,251,054	Cruz et al.	6-2001
5,643,647	Wischusen, III	7-1997

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Fuss et al show a dunnage producing system comprising a dunnage supply having an outlet through which one or more strips are supplied and formed at station 102 wherein the strips may be bent, curled, folded, curved and the like (col 7 lines 15+). Fuss et al show outlet means 106, 108. One portion of the strip will be brought into contact with another part, which reads on a positioning device as claimed (col 7 lines 50+) and the two portions will be bonded. Fuss et al disclose that adhesive may be used as well as other means, such as, stapling (col 2 lines 40+). Fuss shows the claimed subject matter. Regarding manipulating formed strips of dunnage, the examiner notes that the claims do not specifically recite that “formed strips of dunnage” are being supplied. In addition, the examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. See ex parte Thibault, 164 USPQ 666,

667 (Bd. App. 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. See *in re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 8, 9, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuss et al in view of Cruz et al (#6,251,054) or Wischusen, III (#5,643,647).

Fuss et al do not specifically show a coiler or the stapling arrangement as claimed. However, Cruz et al show show a coiler wherein a workpiece is stapled at one of the juxtaposed portions to lock the portions. Cruz et al disclose that the curved path maximizes the use of space (abstract). Wischusen, III shows two juxtaposed portions that are coiled together as shown in figure 4. Wischusen, III discloses that the fastening means may be staples to form locking tabs of a known type (col 4 lines 30+). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Fuss et al with a coiler and stapler arrangement as taught by either Cruz et al or Wischusen, III to maximize the use of space as well as to form locking tabs to lock the juxtaposed areas with stapling means.

Regarding claim 23, the examiner maintains that expressions relating the apparatus to contents thereof during an intended operation are of no significance in

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determining patentability of the apparatus claim. See *ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. See *in re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). Furthermore, the actual configuration of the tab is nothing more than one of numerous configurations a person of ordinary skill in the art would find obvious. See *in re Dailey*, 149 USPQ 47 (CCPA 1976).

Claims 6 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Fuss et al.* (US 5,468,556).

*Fuss et al.* do not disclose the specific staple as claimed. However, the examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. See *ex parte Thibault*, 164 USPQ 666, 667 (Bd App 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. See *in re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *in re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). In the alternative, the examiner takes official notice that it is well known in the art to use plastic staples or the configured staple in claim 7.

#### **(10) Response to Argument**

Appellant argues that claim 1 has to include a positioning device located downstream a dunnage converter and that the examiner is ignoring functional language. This is not persuasive as each claimed element has been shown in the prior art. It is

recognized that while features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473-78, 44 USPQ2d 1429-32 (Fed.Cir. 1997) and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed.Cir. 1990), however appellant has failed to directly point out the functional language being ignored.

The sheet stock material is transformed into relatively less dense dunnage by the operation as provided by Fuss, as admitted by appellant (appeal brief page 7, lines 1+). The sheet stock material is construed as "dunnage" (strips thereof) before and after the stapling procedure. After the stapling procedure takes place the dunnage is considered relatively less dense due to its newly formed shape comprising air/space between portions; see figures 2, 4-9. Note that during patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 904.1.

Regarding the rejections under 35 USC 103(a), as previously noted Fuss shows a positioning device since two ends 96 are joined together. There is no recitation that imparts a sequential order for processing of the strips as argued. The modified invention to Fuss, therefore, reads on the structural limitations as claimed.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Cruz et al. specifically discusses maximizing efficiency in the use of space by the coiler. One of ordinary skill in the art would easily recognize saving space for financial and improved floorplan operations as a reason for modification in an industrial environment.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

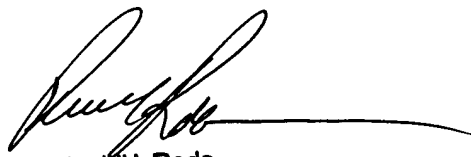

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Chris Harmon, Patent Examiner

Conferees:

Louis Huynh, Primary Examiner

  
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